REMARKS

1. Summary of Office Action

Claims 1-24 are presently pending in this application. In this Office Action, the Examiner objected to claims 10-14 and 19-24. The Examiner also rejected claims 1, 2, 4-9, and 15-18 under 35 U.S.C. § 103(a), as being unpatentable over U.S. Pat. 5,475,819 ("Miller et al."). The Examiner further rejected claims 3 and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. 6,012,088 ("Li et al.") and U.S. Pat. 5,475,819 ("Miller et al.") as applied to claims 1 and 16, respectively above, and further in view of U.S. Pat. 6,560,606 ("Young"). The Examiner additionally objected to the Abstract. Applicants respectfully traverse the rejection of these claims for below stated reasons.

2. Response to Objected to the Abstract

The Examiner objected to the abstract as exceeding 150 words and including the unnecessary phrase "Disclosed are". Accordingly, Applicants have amended the abstract to be less than 150 words and to remove unnecessary phrases. Applicants submit that the abstract is now acceptable and request the Examiner to withdraw his objection.

Additionally, Applicants have amended the paragraph beginning on page 2, line 2 of the specification to add the Patent Application Serial Numbers for the two related, co-pending and commonly assigned U.S. patent applications referenced in the specification. Further, Applicants amended the paragraph beginning on page 20, line 16, of the specification in order to correct a typographical error.

10

3.   Response to Rejection of Independent Claims 1 and 15

a.   Independent Claim 1

Claim 1, as currently amended, provides a method for automatically configuring a client device for communication with a service provider (e.g. an Internet service provider (ISP)). A user of a client device selects a service provider from a plurality of service providers. Next, the user enters user information data (e.g., user's location, a username, user's e-mail address, and credit information) on the client device. The client device then accesses the service provider and provides the service provider with the user information data. The service provider then creates configuration data based on the provided user information data. The client device receives the configuration data and uses it to configure the client device for future communication with the service provider. This is neither taught nor suggested in any of the references cited by the Examiner.

Li et al. discloses a method for configuring an Internet access device for communication with a communications network. In Li et al., a configuration is created based on customer information given to the ISP prior to the time of configuration. Col. 9, lines 26-63. The customer provides customer information to the ISP, which the ISP uses to create a configuration for that customer that is then stored by the ISP in a database. After providing the customer information, the customer then gets a unique account identifier that corresponds to the configuration stored in the database. When the customer later accesses the ISP to configure a device, the customer provides the unique identifier and, in response, the ISP retrieves the corresponding configuration. Col. 9, lines 26-63.

Thus, when the customer accesses the ISP to configure a device, the configuration has already been determined. The customer is not providing information that is used to create the

11

configuration; the customer is providing information that is used to access the predetermined configuration. That is, in Li et al. the configuration file is not created based on user information data provided to the service provider by the user, via the client, at the time of configuration, as is claimed by Applicants. Li et al. therefore does not teach or suggest the invention as claimed in Applicants' claim 1.

In making this rejection, the Examiner refers generally to Figure 10 of Li et al. and also to col. 11, lines 54-57 and col. 12, lines 43-48. The method in Figure 10 does not disclose creating configuration data based on user information data provided to the service provider by the user, via the client, at the time of configuration. In the method in Figure 10, the information is provided prior to the time of configuration and stored in a database which is later accessed for configuration. Similarly, col. 11, lines 54-57 discuss a user inputting an encrypted customer registration ID and phone number of a network access server previously supplied to the customer by the ISP. In this method the encrypted customer registration ID and the phone number are only used to access a previously created database record. Col. 9, line 26 to col. 10, line 26. Again, unlike Applicants' claim 1, the information provided in Li et al. at the time of registration is not used to create the configuration data.

Further, col. 12, lines 43-48 discuss an Internet access device requesting and downloading a unique configuration record for that Internet access device, and using that configuration record to automatically configure the Internet access device. Similar to the earlier discussed section of Li et al., this discussion of requesting, downloading, and configuring using a configuration record does not describe creating configuration data based on user information data provided to the service provider by the user, via the client, at the time of configuration. Nor is this disclosed elsewhere in Li et al.

12

Applicants further submit that Miller et al. does not overcome the deficiencies of Li et al. Miller et al. generally discloses a distributed configuration profile for a computing system that is used for selecting and accessing one of several services on a distributed computing system when a request is made. Col. 1, lines 9-13; col. 6, lines 4-12; col. 6, lines 37-47; col. 9, line 59 to col. 10, line 22. The services provided in Miller et al., such as in response to remote procedure calls ("RPCs") "may be hardware facilities, such as high speed printers, back-up disks, or the like, or may be software facilities, such as name services, global data base utilities, or the like." Col. 3, lines 27-31.

Thus, Miller et al. deals with a distributed computing system services rather than the entirely different field of Internet Service Provides and the like. Fig. 1; Col. 1, lines 9-13; col. 4, lines 2-29. Further, in Miller et al., the configuration data is not created based on user information data provided by a user, via the client device, at the time of configuration. Col. 6, lines 37-48. Miller et al. therefore does not teach or suggest creating configuration data based on user information data provided to the service provider by the user, via the client device, at the time of configuration.

Additionally, no motivation exists to combine Miller et al. with Li et al. In Li et al., the user contacts the ISP prior to the time of configuration and provides the ISP with all customer information needed for configuration of the Internet access device. Col. 9, lines 26-63. This customer information is stored by the ISP in a database with an associated customer account identifier number. Col. 9, lines 26-63. The ISP gives this customer account identifier number to the customer, along with an ISP access number. Col. 9, lines 26-63. The user then provides the customer account identifier number to the ISP, via the internet access device, at the time of

13

configuration, to allow the ISP to access the database containing the appropriate customer information. Col. 9, lines 26-63.

As a result, if Miller et al. were combined with Li et al., the customer would have to contact all of the possible ISPs and provide each one with his customer information needed for configuration, prior to the time of configuration, in order to later select one of the ISPs for configuration using the customer identifier number provided by that ISP. This would be time-consuming and inefficient. Therefore, no motivation exists to combine Miller et al. with Li et al.

As discussed above, none of the references cited by the Examiner teach or suggest creating configuration data based on user information data provided to the service provider by the user, via the client, at the time of configuration. Additionally, no motivation exists to combine Miller et al. with Li et al. Therefore, the combination of Li et al. and Miller et al. does not render obvious Applicants' currently amended independent claim 1. Independent claim 1 is therefore allowable. As a result, dependent claims 2-14 are also allowable.

a.   **Independent Claim 15**

Claim 15, as currently amended, also provides the claim limitation of a service provider generating configuration data based on the user information data provided by the user at the time of configuration. For the reasons previously discussed, independent claim 15 is therefore allowable. As a result, dependent claims 16-24 are also allowable.

CONCLUSION

In conclusion, Applicants submit that Miller et al. combined with Li et al. does not render obvious the invention as recited in claims 1-24. Therefore, Applicants submit that the application is in condition for allowance and respectfully request early notice to this effect. If

14

any questions or issues remain, the Examiner is invited to contact Applicants' attorney, Brian

Harris, at his direct dial number (312) 913-3303.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF**

Date: 11/13/03   By: _____

Brian R. Harris
Registration No. 45,900

15